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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,720	09/22/2000	William J. Ryan	1711.0040004/RWE	9377

26111 7590 07/18/2003

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

8

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,720

Applicant(s)

RYAN ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 10-13, 21-24 and 29-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 14-20 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-4. 6) ☐ Other:

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1. This application contains claims 6-8, 10-13, 21-24, and 29-90 which are drawn to an invention nonelected with traverse in Paper No. 6 of 7/31/02. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

2. Applicant's election with traverse of group I, claims 1-20 and 25-28 and the species of the acrylic acid copolymer species of claims 1-5, 9, 14-20, and 25-28 read in Paper No. 6 of 7/31/02 is acknowledged. The traversal is on the ground(s) that

I. the inventions must be independent or distinct as claimed **and** there must be a serious burden on the examiner if restriction is not required

II. the examiner provides no description of the intermediate final product relationship of groups I and II

III. there are a reasonable number of species claimed.

IV. when inventions are a species under a claimed genus and related...criteria for restriction must be addressed according to MPEP 806.04(b)...

This is not found persuasive because (the following paragraph numbers correspond to the paragraph numbers of the above traversals)

I. The inventions are independent and distinct as set forth in the restriction requirement of paper number 5 of 7/1/02. In response to the applicant's representative's arguments that there is not a serious burden on the examiner to search all of the inventions of the instant application together, this examiner has only 14 hours to examine the entirety of the instant application. This includes

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every aspect of examination from reading the application and understanding the invention to searching to disposal of the application. Thus, there is clearly a serious burden on the examiner to search more than one independent or distinct invention.

II. I is a composition and II is the composition on a carrier. The intermediate final product relationship is clear as the final product contains a carrier not required by the intermediate product and there will be bonds, either secondary or covalent depending on the natures of the carrier and the composition, which are not present in the intermediate product. The intermediate therefore loses its identity when these bonds which are not present in the intermediate composition, are formed in the final product. That groups I and II are closely related according to the applicant is not persuasive as the above arguments clearly show that the two groups are restrictable from each other. If the applicant is aware of prior art containing both subject matters, the examiner will consider it.

III. the independent claims encompass an infinite number of species and permutations of the claimed compositions. This is impossible to consider which is clearly not reasonable.

IV. One could say that everything falls under the genus of "stuff". This would be analogous to the applicant's argument of the instantly claimed genus. It is recognized that the so-called genus of the applicant's claims is huge as evidenced clearly by the huge number of classes and subclasses that are necessary to make inventions at all searchable and species elections in cases such as the instant application are recognized as proper. It is the examiner's position that the MPEP section cited is directed to more manageable genres. There is not an ionomer in polar

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solvent subclass. This so-called genus requires searching of all of the polymer composition subclasses which is not possible in the time allotted the examiner for a single application. Thus the species are recognized as distinct by the fact that they are classified differently and the huge search is clearly a burden as it is not possible in the time allotted the examiner.

The requirement is still deemed proper and is therefore made FINAL.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-5, 9, 14-20, and 25-28 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of all of the pending claims of copending Application No. 09/867983, which has been allowed but the issue fee has not been matched with the file as of 7/13/03. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-5, 9, 14-20, and 25-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all of the pending claims of copending Application No. 09/867983. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although the claims differ somewhat in scope, they still overlap such that it would have been obvious to the ordinary skilled

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artisan at the time of the instant invention to perform the instantly pending invention as that of the copending claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5, 9, 14-20, and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by WO97/16492 as translated by US Pat. No. 6001911 Ishizaki et al..

Ishizaki discloses a composition containing the instantly claimed ingredients and amounts and must therefore inherently be "susceptible". See the abstract; column 3, lines 63-68; column 4, lines 1-16; column 10, lines 63-68; column 11, lines 1-31; column 14, lines 55-62; column 30, lines 6-7; column 31, lines 16-17; and the remainder of the document. The abstract shows the polymer to be film forming. It is therefore necessarily useful in coating or bonding since it can obviously bond or coat itself. The polyol is expected to inherently plasticize the polyacrylate. It

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is therefore also the plasticizer of the instant claims. The limitations of the instant claim 20 are necessarily met since the composition contains the instantly claimed ingredients and amounts thereof.

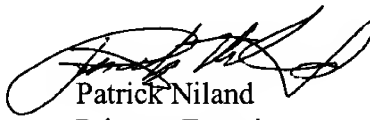
10 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

July 13, 2003


Patrick Niland
Primary Examiner
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